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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,251	08/03/2001	Yoshio Harada	P21030	6273

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RESTON, VA 20191

EXAMINER

SAVAGE, JASON L

ART UNIT	PAPER NUMBER
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1775

DATE MAILED: 09/24/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/890,251

Applicant(s)

HARADA ET AL.

Examiner

Jason L. Savage

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1775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 7-12, 14 and 16-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2, 3, 7-12, 14, 16-18, 25-34 and 36-44 is/are allowed.
- 6) ☒ Claim(s) 1, 23 and 35 is/are rejected.
- 7) ☐ Claim(s) 19-22 and 24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152). |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>11, 12</u> . | 6) <input type="checkbox"/> Other: _____ |

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Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 23 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP'467 (JP 10-045,467).

JP'467 teaches a substrate for a plasma treating vessel having a coating thereon which comprises Y_2O_3 and Al_2O_3 (abs.). JP'467 is silent to using a spraying method to form the Y_2O_3 containing coating; however claim 1 is drawn to the article, not the method of making. Absent a teaching of the criticality of the claimed method, it does not provide a patentable distinction over the prior art. It would have been obvious to one of ordinary skill in the art at the time of the invention to have used any suitable method for forming the coating taught by JP'467. When there is a substantially similar product, as in the applied prior art, the burden of proof is shifted to the applicant to establish that their product is patentably distinct not the examiner to show that same process of making, see *In re Brown*, 173 U.S.P.Q. 685, and *In re Fessmann*, 180 U.S.P.Q. 324.

Regarding claims 23 and 35, the coating of JP'467 meets the claim limitation of consisting essentially of Y_2O_3 .

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Allowable Subject Matter

3. Claims 19-22 and 24 are objected to as being dependent upon rejected base claim 1, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
4. Claims 2-3, 7-12, 14, 16-18, 25-34 and 36-44 are allowed.
5. The following is a statement of reasons for the indication of allowable subject matter: The prior art teaches coatings for plasma treating vessels wherein the coating comprises a surface layer of Y_2O_3 such as is claimed by Applicant. However, the prior art does not teach a coating containing a Y_2O_3 surface layer which further contains an metal film undercoat or an undercoat with a middle layer formed between the undercoat and the Y_2O_3 surface layer.

Response to Arguments

6. Applicant's arguments filed 6-17-03 have been fully considered but they are not persuasive.

Applicant argues that JP'467 does not teach or suggest that the coating is applied by a spraying method such as recited in the claims. However, as was noted in the rejection above, the claims are drawn to an article, not the method of making. Absent a teaching or showing of the criticality of a spraying method, it does not provide a patentable distinction over the prior art. Applicant cites example 2 and the teaching on page 9, lines 3-6 of the specification as evidence of the criticality of the spraying method. Example 2 teaches multiple coatings containing

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different materials being applied by different methods. Applicant is directed to Sample No. 7, which is a Y_2O_3 coating applied by a PVD process, having a damaged depth through erosion which is within the range of Samples 2, 4 and 6. Thus, it is unclear how Example 2 can be cited as evidence that the claimed method of forming is critical to the formation of the product. In fact, Example 2 teaches the opposite of Applicant's assertion, that a similar coating can be formed by PVD, one of the methods taught by JP'467.

The recitation on page 9, lines 3-6 state that the inventive coating has improved resistance in an atmosphere containing a halogen compound, however there is no teaching that a similar coating, formed by an alternate process such as PVD would not also exhibit the enhanced resistance in a halogen containing atmosphere. Applicant's has failed to show that the process limitation is critical to the structure of the final product.

As further evidence that the claim limitation of spraying is not critical to the structure of the product, the Examiner cites claims 9 and 10 which state 'applying at least one surface treating process selected from CVD process, PVD process and thermal spraying process'. From this disclosure, it appears that Applicant views the CVD, PVD and spraying processes as interchangeable and as such, the process used to form the coating is not a critical limitation.

Regarding claims 23 and 35, Applicant argues that JP'467 does not teach that the coating consists essentially of Y_2O_3 . However, the limitation of consisting essentially of only limits the scope of the claim to specified materials or steps which do not materially affect the basic and novel characteristics of the claimed invention. Since the article of JP'467 is suitable for use in a

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plasma treating vessel and since Applicant has not taught or shown how the inclusion of the materials recited by JP'467 would affect the basic and novel characteristics of the claimed invention, the coating of JP'467 is viewed as meeting the limitation of consisting essentially of Y_2O_3 .

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

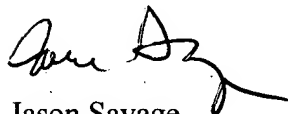
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry to this communication or earlier communications from the Examiner should be directed to Jason Savage, whose telephone number is (703)305-0549. The Examiner can normally be reached Monday to Friday from 6:30 AM to 4:00 PM.

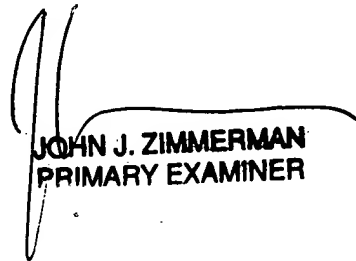
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If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Deborah Jones, can be reached on (703)308-3822.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-2351.


Jason Savage

9-17-03


JOHN J. ZIMMERMAN
PRIMARY EXAMINER